

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID M. FENWICK, DENIS FOLEY and
STEPHEN R. VAN DOREN

Appeal No. 1997-3837
Application No. 08/269,251

ON BRIEF

Before KRASS, JERRY SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-14,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a system for early arbitration for access to the system bus prior to the system determining whether access to the bus is required. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A commander module, coupled to a system bus including system bus control request signals wherein said commander module is associated with one of said system bus control request signals, comprising:
means for determining whether control of said system bus is required; and
means for requesting control of said system bus, prior to said determining means determining whether such control is required, by asserting said associated system bus control request signal.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Irwin	4,703,420	Oct. 27, 1987
Schanin et al. (Schanin)	5,067,071	Nov. 19, 1991
Moyer et al. (Moyer)	5,416,910	May 16, 1995
		(Eff. filing date Mar. 4, 1992)

Claims 1-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schanin. Claims 13-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moyer in view of Irwin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's

answer (Paper No. 13, mailed Apr. 28, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 12, filed Jan. 17, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that the Schanin reference does not teach or suggest the "means for requesting control of said system bus, prior to said determining means determining whether such control is required" as recited in claim 1. We agree with appellants. The examiner states that Schanin does not teach or suggest this critical feature of the claimed invention on page 4 of the answer. The examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to request control of the system bus prior to determining whether control was required "because this feature would allow for initialization of the commander modules and would allow the commander modules to interface with the bus and determine whether further access of the bus is required by a particular command module." (See answer at page 5.) Appellants argue that the

examiner's statement of a line of reasoning is not a logical motivation in view of the prior art teachings of Schanin. (See brief at page 15.) We agree with appellants.

From our review of the prosecution history, the examiner has merely continued to repeat the same text as set forth in the first office action and has not responded to appellants' arguments. The examiner merely cuts and pastes the same text as the rejection where he asserts that a response to the argument has been made and the examiner maintains the unyielding position without explanation. We do not find this an acceptable practice by the examiner to the appellants and to this Board. Since the examiner has not responded substantively to appellants' arguments and in our view, we do not agree with the examiner's asserted unsupported line on reasoning for modifying Schanin, we find that the examiner has not set forth a ***prima facie*** case of obviousness with respect to Schanin alone. Therefore, we will not sustain the rejection of claims 1-12.

Similarly, the examiner relies on Moyer to teach the claimed invention and again states that the same claim limitation, concerning requesting control of the system bus prior to determining whether control is required, is not taught or suggested by Moyer. The examiner states the "Irwin discloses all of the above mentioned features of the present invention." The examiner then cites to the entire detailed disclosure. (See answer at page 8.) Again, we do not find the examiner's practice of citing the entire detailed disclosure to

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be an acceptable practice to the appellants and to this Board. We have reviewed the entire cited portion of Irwin and do not find even a hint of suggestion of the prior or early arbitration as the examiner maintains. Irwin is concerned with the use of the bus by a coprocessor and preventing the coprocessor from monopolizing the bus and not early arbitration as recited in the claimed invention. Therefore, we will not sustain the rejection of claims 13 and 14.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-14 under
35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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